Changes to implement provisions of 2020 Trademark Modernization Act (TMA)

Amy P. Cotton
Deputy Commissioner for Trademark Examination Policy
June 2021
Notice of proposed rulemaking (NPRM)

• Contains draft rules on:
  – Letters of protest
  – Response times for office actions
  – New ex parte nonuse proceedings
  – Attorney recognition for representation
  – Court orders concerning registrations
NPRM

• All proposed rules in the NPRM are subject to change.
• Rules will not take effect until date indicated in the final rule.
• Roundtable comments are considered informal and will not form part of the formal rulemaking record unless submitted in writing to regulations.gov.
Letters of protest
Letters of protest rule

• Third-party protest
  – Third parties may submit for consideration for inclusion in the record evidence relevant to a ground for refusal of registration.
  • NPRM amends existing rule to indicate that letter-of-protest determinations are final and non-reviewable.
Flexible response period
Flexible response period rule

• NPRM describes three options.
• All options apply to both applications and post-registration office actions.
• Shortened response periods would not apply to Section 66a applications.
Flexible response period rule

• Options:
  1. Three-month response period, with one extension
  2. Two-phase examination
  3. Patent model
Nonuse cancellation mechanisms
Nonuse cancellation mechanisms

- New proceedings available
  - Expungement
    - Also a new claim at the Trademark Trial and Appeal Board (TTAB)
  - Reexamination
Nonuse cancellation mechanisms

• Filing a petition
  – $600 per class
  – USPTO.gov account
  – Petitioner’s name, domicile address, and email address
  – Verified statement
  – Documentary evidence of nonuse
Nonuse cancellation mechanisms

• Reasonable investigation sources
  – State and federal trademark records
    • Other regulatory filings
  – Websites or print sources
    • Controlled by registrant
    • Where relevant goods/services likely offered for sale
    • Where reviews or discussion of relevant goods/services are likely
Nonuse cancellation mechanisms

• Reasonable investigation sources
  – Registrant’s marketplace activities
    • Including attempts to purchase
  – Litigation or administrative proceeding records
Nonuse cancellation mechanisms

• Prima facie case
  – USPTO Director decides whether prima facie case is made
  – If prima face case is made, Director must institute proceedings
  – Director’s decision to institute is final and non-reviewable

• Institution
  – Office action issues with two-month response period
Nonuse cancellation mechanisms

• Registrant’s response
  – Acceptable response options:
    • Documentary evidence of use
    • Verified statement and evidence of excusable nonuse
      – Applies only to Section 44 or 66 registrants in an expungement proceeding
    • Deletion of goods or services
      – If acceptable, proceedings terminate
Nonuse cancellation mechanisms

• Registrant’s response
  – Non-response
    • Failure to respond results in immediate cancellation in whole or in part
  – Unacceptable response
    • Final action issues, continuing requirements, with two-month response period
Nonuse cancellation mechanisms

• Response to final action
  – Request reconsideration
  – Appeal to TTAB
Nonuse cancellation mechanisms

• Estoppel
  – Goods and services for which use in commerce has already been established cannot be subject to further proceedings
Nonuse cancellation mechanisms

• Relationship to other proceedings
  – Expungement and reexamination proceedings are included among the types of proceedings for which suspension of action by the Trademarks organization or the TTAB is authorized.
  – TTAB will suspend proceedings when another proceeding that is relevant to registrability (not limited to same party/parties) is ongoing.
Nonuse cancellation mechanisms
Attorney recognition for representation
Recognition for representation

• Recognition for representation continues until revocation or withdrawal
  – Owners and attorneys must proactively file revocation or withdrawal documents.
Withdrawal from representation

• Clarifying attorney obligations for withdrawal
  – Rule differentiates the grounds under which the attorney may request to withdraw versus those situations where an attorney must request withdrawal.
Court orders
Court orders

• Codifying USPTO’s longstanding procedures concerning action on court orders cancelling or affecting a registration

  – The USPTO requires submission of a certified copy of the court order and normally does not act on such orders until the case is finally determined.
NPRM comments

• Send formal comments to www.regulations.gov
• Docket number PTO-T-2021-0008
• Deadline for formal comments: July 19, 2021
TMA resources

• USPTO website
  – Public roundtables on June 1 and June 14, 2021
  – Send questions to TMFeedback@uspto.gov

• TMA legislation

• TMA Committee Report
## Letter of protest and response period rules

<table>
<thead>
<tr>
<th>Conforming amendment to rule for letters of protest</th>
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<tbody>
<tr>
<td><strong>37 C.F.R. § 2.149</strong></td>
<td>Protest determination is final and non-reviewable</td>
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<thead>
<tr>
<th>Conforming amendments for shortened response periods</th>
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<tbody>
<tr>
<td><strong>37 C.F.R. § 2.62</strong></td>
<td>Three-month response period for responses to Office actions in applications under sections 1 and/or 44 of the Act; three month extension available</td>
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<tr>
<td>§ 2.63</td>
<td>Fee for requesting extension to file response</td>
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<td>§ 2.65</td>
<td>Application abandons for failure to respond to office action within relevant time period of response, including extensions of time to respond</td>
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<td>§ 2.66</td>
<td>Petition to revive must include the extension fee if request for extension filed after the three-month response period</td>
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<tr>
<td>§ 2.141; 2.142</td>
<td>Appeal to TTAB from ex parte refusal made within time period for response including any granted extension of time to respond or appeal</td>
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<tr>
<td>§ 2.163; 2.165; 2.184; 2.186; 7.39; 7.40</td>
<td>Three-month response period for responses to post-registration office actions; three month extension available</td>
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<tr>
<td>§ 2.6; 7.6</td>
<td>Fee for extensions</td>
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## Nonuse cancellation rule sections

<table>
<thead>
<tr>
<th>New rules for nonuse cancellation</th>
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<tbody>
<tr>
<td><strong>37 C.F.R. § 2.91</strong></td>
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<tr>
<td><strong>§ 2.92</strong></td>
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<td><strong>§§ 2.93 - 2.94</strong></td>
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<td><strong>§ 2.143</strong></td>
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<tbody>
<tr>
<td><strong>§ 2.11</strong></td>
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<td><strong>§ 2.23</strong></td>
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<tr>
<td><strong>§ 2.67; 2.117</strong></td>
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<tr>
<td><strong>§ 2.111</strong></td>
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<td><strong>§ 2.141 – 2.142</strong></td>
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<td><strong>§ 2.145</strong></td>
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<td><strong>§ 2.146</strong></td>
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<td><strong>§ 2.193</strong></td>
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# Recognition and court order rules

## Recognition of representation and withdrawal

<table>
<thead>
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<th>Description</th>
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<tbody>
<tr>
<td><strong>37 C.F.R. § 2.17</strong></td>
<td>Fraudulent designation of representative is ineffective; recognition continues until representative withdraws from representation</td>
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<td><strong>§ 2.18</strong></td>
<td>Correspondence only with representative; exception for service of notice of cancellation and notices of institution of expungement/reexamination proceedings</td>
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<td><strong>§ 2.19</strong></td>
<td>Withdrawal; no withdrawal needed if recognition is ineffective</td>
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## Court orders rule change

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<tr>
<td><strong>37 C.F.R. § 2.177</strong></td>
<td>Court orders concerning registrations must be certified and sent to Director after the proceeding is finally determined</td>
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